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No.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1988

STEELCASE INC.,

Petitioner,

v.

HAWORTH, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

JOSEPH N. ONEK
PAUL M. SMITH
ONEK, KLEIN & FARR
2550 M Street, N.W.
Washington, D.C. 20037

DAVID S. FRY
JON D. BOTSFORD
STEELCASE INC.
901 44th Street, S.E.
Grand Rapids, Michigan 49508
Of Counsel

RUDOLF E. HUTZ
Counsel of Record
JOHN D. FAIRCHILD
CONNOLLY, BOVE, LODGE & HUTZ
1220 Market Building
P.O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141
Counsel for Petitioners

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

QUESTION PRESENTED

Whether a reviewing court, in a patent infringement action, may reject an interpretation of a patent claim made by the district court, where that interpretation is based on factual findings not found to be clearly erroneous, and may proceed to find infringement in the face of other valid findings that provide a complete defense.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Steelcase Inc. petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is reprinted as Appendix A and is not reported. The opinion of the United States District Court for the Western District of Michigan, Southern Division, is reprinted as Appendix C and reported at 685 F. Supp. 1422 and 8 U.S.P.Q.2d 1001 (1988).

JURISDICTION

The decision of the Court of Appeals sought to be reviewed was filed on January 23, 1989. The Court of Appeals denied Steelcase's petition for rehearing on Febru-

ary 17, 1989. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

RULE INVOLVED

Rule 52(a), Fed. R. Civ. P., reads:

> *Findings By the Court*
>
> (a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses * * *.

STATEMENT OF THE CASE

This case is a patent infringement action brought by respondent Haworth, Inc. (Haworth) against petitioner Steelcase Inc. (Steelcase), where the United States Court of Appeals for the Federal Circuit followed a pattern it has established in recent years by ignoring key factual determinations of the district court and engaging in a kind of *de novo* review that rendered a lengthy infringement trial largely superfluous.[1] In this case, moreover, despite the explicit instructions of this Court in *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809 (1986) (*per curiam*), the court of appeals explained its decision

[1] The only parties in this case are as listed in the caption. Pursuant to Rule 28.1, petitioner Steelcase Inc. has no parents or subsidiaries. It is a partner in a French joint venture called Steelcase-Strasfor with a publicly held company called Financiere Strasfor S.A.

to disregard the trial court's fact-based judgments only in a cursory unpublished order that clearly fails to provide a sufficient justification. Petitioner asks this Court to review the case in order to restore the proper roles of trial and appellate courts in the patent field.

The infringement claims at issue here involve electrified, moveable wall panels, developed in the early 1970s, which serve to separate office workers and also bring electrical power to each person's desk. American sales of electrified panels, by the parties and several other companies, now total hundreds of millions of dollars annually. In 1985, respondent Haworth, the developer of one such product, brought suit against petitioner in the United States District Court for the Western District of Michigan, claiming that several of Steelcase's electrified wall panel product lines infringed two Haworth patents.[2]

After a 23-day trial, the district court issued a detailed, 68-page opinion in which it upheld the validity and enforceability of the Haworth patents but also held that the relevant Steelcase products do not infringe. In arriving at the latter holding, the court carefully compared the specific language of the patent "claims" with the accused Steelcase products and found numerous differences precluding a finding of literal infringement. Pet. App. 45a-53a. In each instance, the court also applied the doctrine of "equivalents," under which a product can be held infringing even if it does not match the literal terms of a patent claim but " 'performs substantially the same function in substantially the same way to obtain the same result.' "[3] It agreed that the Steelcase products performed the same basic function as that described in

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[2] Haworth has also threatened to bring actions against other manufacturers of similar products, and the outcome of the present case is likely to affect the entire industry.

[3] *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950) (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)).

the Haworth patents, but held that they did so in substantially different ways. Indeed, the court noted the telling fact that Haworth itself had subsequently altered its products to incorporate some of the key innovations in the Steelcase designs. Pet. App. 42a-43a.

On January 23, 1989, a panel of the Federal Circuit reversed in a five-page unpublished order.[4] That court, after summarizing the district court's holdings on the infringement issue, proceeded to reject each of them on the ground that they were based on too narrow a reading of Haworth's patent claims. It stated that claim interpretation is "'a question of law,'" Pet. App. 3a (quoting *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 866 (Fed. Cir. 1985)), and accorded no deference to the district court's analysis of the meaning of key terms of art in the claims, which, in turn, was based on familiarity with the products at issue. To the contrary, the court of appeals simply stated, in conclusory fashion, its different understanding of the scope of those terms. Pet. App. 3a-4a.

Having thus "reconstru[ed] the claims," the court held that "Haworth's asserted claims are infringed, either literally or under the doctrine of equivalents." Pet. App. 4a. It did not state which of Steelcase's products, if any, fell within the literal terms of a Haworth patent, or provide any further explanation of why these products infringe the asserted claims in those patents. Moreover, it did not even mention the district court's basic finding that the Steelcase products performed the same basic function in "substantially different," and superior, ways —a finding that did not depend on the district court's interpretation of the claims and is sufficient to rule out liability for infringement. The court remanded the case for further action consistent with the decision.

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[4] Although it was *reversing* a complex district court ruling, which, in turn, was based in large part on facts shown at a lengthy trial, the court of appeals indicated that its decision was not of significant interest and was not citeable as precedent.

REASONS FOR GRANTING THE WRIT

The approach to appellate review adopted by the Federal Circuit in this case is clearly indefensible. On appeal from a judgment entered after a full trial on the merits, that court made two determinations that rendered the district court's lengthy weighing of the evidence largely irrelevant. First, despite the fact that district court's claim interpretations were properly based in part on "extrinsic evidence," including testimony, the court of appeals treated those interpretations as purely legal holdings subject to no deference whatever. Second, having pronounced an altered interpretation of the claims, the court undertook to determine for itself the factual issue of infringement and, in so doing, simply ignored district court findings that provided a complete defense.

As we discuss *infra*, the Federal Circuit has, in recent years, established a pattern of disregarding factual findings, even in the face of this Court's instructions to the contrary three Terms ago in *Dennison Mfg. Co. v. Panduit Corp.*, *supra*. In *Dennison*, the Federal Circuit had overturned a fact-based ruling of a district court without mentioning the clearly erroneous standard of Fed. R. Civ. P. 52(a) or explaining its inapplicability. 475 U.S. at 811. This Court remanded for an appropriate Rule 52 analysis. The Federal Circuit, however, continues to ignore the same rule in numerous contexts, and thus there is a clear need again for review by this Court.

The instant case would provide an especially appropriate opportunity for such review in light of the almost cavalier attitude reflected in the ruling of the court of appeals. This case involves patents potentially impacting, industry-wide, on billions of dollars worth of past and future sales. Those claims were resolved by the district court in a careful and lengthy opinion after an extended trial on the merits. The court of appeals, however, reversed that judgment in a five-page unpublished order that fails even to address the bulk of the findings and

reasoning presented by the district court and petitioner to support the determination of non-infringement.

1. The first step in an analysis of alleged infringement is determining the scope of the relevant claims in light of their language, their "prosecution history," the specifications provided in the same patent, the prior art, and the language used in other claims. *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987); *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1118 (Fed. Cir. 1985). Just as in the area of contract interpretation,[5] the scope of a patent claim—where the meaning of the relevant language is undisputed—is ultimately an issue of law. *Coupe v. Royer*, 155 U.S. 565 (1895); *Loctite Corp. v. Ultrascal, Ltd.*, 781 F.2d 861, 866 (Fed. Cir. 1985).

In many infringement cases, however, it is necessary first to resolve issues of fact involving the meaning of key terms used in claims, specifications, or the prosecution history. *Perini America*, 832 F.2d at 584; *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988). This is especially true in the patent field because claims are "normally construed as they would be by those of ordinary skill in the art." *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1571 (Fed. Cir. 1983). In such cases, testimony by persons with the relevant expertise is often required. *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 657 (Fed. Cir. 1986); *McGill Inc. v. John Zink Co.*, 736 F.2d 666, 675 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984). Similar factual issues may arise when the prosecution history and prior act are themselves disputed and complex. *Palumbo v. Don-Joy Co*, 762 F.2d 969, 976-77 (Fed. Cir. 1985). Frequently, it is the resolution of such subsidiary factual questions that effectively controls the outcome on the issue of claim interpretation. *Perini America*, 832 F.2d at 584.

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[5] *See* Restatement (Second) of Contracts § 212(2); E. Farnesworth, *Contracts* § 7.14 (1982).

On appeal, it is well-established that district court findings on these subsidiary factual issues must be reviewed under the "clearly erroneous" standard of Fed. R. Civ. P. 52(a), notwithstanding the principle that claim interpretation itself is ultimately an issue of law. *Id.; Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d at 882.[6] The Federal Circuit's adherence to this approach, however, can only be described as intermittent. In some cases, claim interpretations have been upheld partly on the basis of underlying factual findings deemed not clearly erroneous. *See, e.g., Hybritech Inc. v. Abbott Laboratories*, 849 F.2d 1446, 1455 (Fed. Cir. 1988); *Perini America*, 832 F.2d at 584-86.[7] In others, the court has rejected claim interpretations by simply reciting the principle that such interpretations are questions of law and proceeding to consider the issue *de novo*, without according deference to relevant factual determinations made in the district courts. *See, e.g., Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986 (Fed. Cir. 1988); *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d at 1569-71; *Bausch & Lomb, Inc. v. Barnes-Hind/*

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[6] *See Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904) (interpretation of claim an issue of law where "extrinsic evidence is not needed to explain terms of art therein"); *cf. Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. at 811 ("whether or not the ultimate question of obviousness is a question of fact subject to Rule 52(a), the subsidiary determinations of the District Court, at the least, ought to be subject to the Rule"). The need for deference to trial court findings is especially great where the issues are technical and complex. *See Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 336 U.S. 271, 274 (1949) ("To no type of case is this last clause [of Rule 52(a)] more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations.")

[7] *See also Tandon Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017, 1021 (Fed. Cir. 1987) (applying "substantial evidence" standard); *McGill, Inc. v. John Zink Co.*, 736 F.2d at 675 (same).

Hydrocurve, Inc., 796 F.2d 443, 450 (Fed. Cir. 1986), *cert. denied*, 108 S. Ct. 85 (1987). As two examples of the claim interpretation issues decided below demonstrate, this case falls into the second, highly questionable category.

"*Fixedly Mounted.*" A key feature of all of the patent claims at issue here is their requirement that the electrical components at the base of the Haworth wall panels be "fixedly mounted." In the district court, petitioner took the position that this description limited the claims to panels, like the only product described in the Haworth patents, that (1) generally have the electrical components factory-installed, (2) cannot have the electrical components installed or removed while in their usual standing position, and (3) are not intended to be optionally used without electrical components. It pointed to the description of the electrical components in one of the Haworth patents as an "integral part" of the wall panels.[8] Steelcase contrasted these features with its own products, which have electrical components attached to them as an option that can be installed and removed as the customer chooses.

This understanding of the term "fixedly mounted" was supported by testimony from the inventor of the Haworth panels, who conceded that the only products described in the patent specifications were intended to have electrical components pre-installed at the factory. It was also supported by the prior art in existence at the time Haworth began filing the relevant claims. Specifically, Haworth was aware of an earlier "Modulo 3" wall panel that had optional wiring that easily "snapped on" and "snapped off" the base. Pet. App. 59a. Haworth's consistent em-

[8] This language is contained in both claims 5 and 29 of U.S. Patent No. 4,370,008. The Haworth panels, as originally designed and as described in the claims, required that the electrical components be in place in order to fill a gap that would otherwise exist between the floor and the bottom of the panel.

phasis on the "fixedly mounted" nature of its electrical components, in repeated patent filings, must be construed as part of an effort to differentiate its product from this prior art. Finally, Steelcase's interpretation of the phrase "fixedly mounted" was supported by other, non-asserted claims filed by Haworth in which it used a different phrase—"fixedly but removably connected"—to refer to components that could be easily and optionally removed. Pet. App. 44a.

The district court, having considered this evidence and physically examined the wall panels themselves,[9] adopted petitioner's understanding. It found that the "claim limitation 'fixedly mounted' is otherwise unqualified, definite and positive. It does not mean only [*sic*] that the power blocks are removable from the panels. When Haworth wanted to define something different in some of the other patent claims, it used the broader term 'fixedly but removably connected.'" *Id.* The court went on to draw a distinction between the claims as written and petitioner's products. It stated that the "electrical components of the accused Steelcase products were designed to be fundamentally different optional accessories, which are not fixedly mounted as part of the panels. . . . Unlike the panels described and claimed in the Haworth patents, the Steelcase panels may be used with or without the electrical components." *Id.*

On appeal, however, the district court's careful analysis and weighing of the evidence on the meaning of this term was rejected in two conclusory sentences. The Federal Circuit held that "[n]othing in the prosecution history, prior art or specification" requires that the relevant claim language be limited to "non-removable power blocks. Rather, the specification discloses a power block

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[9] The panels were not, because of their size, included in the record on appeal.

'disposed for slidable engagement' and the use of a screw for securing the block to the panel." Pet. App. 3a.

This analysis, to begin with, misses the point, since it focuses only on the physical possibility of removing the electrical components in the Haworth panels as described in the specifications, irrespective of the difficulty and consequences of such removal. The district court, by contrast, had interpreted "fixedly mounted" as indicating that the components were an integral part of the panel design—*i.e.*, that the panels would not remain functional with those components removed.[10] Moreover, in concluding in effect that "fixedly mounted" is synonymous with "fixedly but removably connected," the court of appeals gave no deference whatever to the district court, which had heard relevant testimony and had examined both the accused products and the relevant prior art. It simply came to a different conclusion on its own.

"*Cooperating Hinge Parts*" Another example of the Federal Circuit's flawed approach is its treatment of the requirement in one of the asserted claims[11] that there be an "electrical connector" for joining two wall panels that "includes hinge means for permitting relative angular displacement" and has "cooperating hinge parts." This requirement is significant because the only design disclosed by Haworth in the patent and originally marketed by that company included a fixed "hinge" connector made up of separate "hinge parts," whereas the accused Steelcase panels were joined by one-piece flexible plastic straps. Pet. App. 42a-43a.

The district court held that the relevant claim language should be read to require a "fixed pivot axis hinge arrangement"—*i.e.*, a conventional "hinge"—and thus did

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[10] As noted above, if the electrical components were removed, there would be a significant gap between the bottom of the panel and the floor.

[11] The relevant claim is Claim 18 of U.S. Patent Re. 31,733.

not apply to a product using the Steelcase connecting strap. Pet. App. 46a. In so holding, it relied on the prosecution history of the claim, noting that it was the addition of the specific "hinge" language that persuaded the Patent Office to accept this claim after rejecting others. Pet. App. 47a. The district court also noted that this same language was the basis on which Haworth distinguished its patent from the prior art reflected in patents previously filed. *Id.* The district court reached these conclusions after hearing competing evidence and arguments from both sides.

Here again, however, the Federal Circuit simply rejected this careful analysis, stating that the claim was "improperly confined to the hard plastic shell, fixed-pivot device disclosed in the specification and embodied in Haworth's commercial product." Pet. App. 4a. It did not even address the prosecution history and prior art on which the district court relied.

These two examples illustrate well how the Federal Circuit improperly rejected the key claim interpretations of the district court. In each case, the district court had carefully canvassed relevant indications in the prior art and the prosecution history, and had heard testimony by knowledgeable personnel from both sides. The court of appeals, however, simply made its own judgment, without even having the benefit of an examination of the physical products themselves.

2. The Federal Circuit's approach was equally indefensible when it reached the second issue here—infringement of the relevant claims by petitioner's products. This issue has always been viewed as a factual one, requiring a comparison between the claims as interpreted and the accused products as they exist. *Perini America*, 832 F.2d at 586. Here, the Federal Circuit, having "reconstru[ed]" the claims, proceeded to deal itself with the infringement issue in a single sentence, asserting that

"Haworth's asserted claims are infringed, either literally or under the doctrine of equivalents, by Steelcase's panels." Pet. App. 4a.

Such a cursory approach might be permissible in a case where the valid findings of the district court, combined with the claims as reinterpreted, leave no doubt on the issue of infringement.[12] *See United States v. Telectronics, Inc.*, 857 F.2d 778, 784 (Fed. Cir. 1988), *petition for cert. filed* (No. 88-1397, Feb. 21, 1989) (cited at Pet. App. 4a) (finding infringement, after reinterpreting claims, in a case where the parties and district court had recognized that the sole issue was one of claim interpretation). Here, however, the situation was far different. Although the Federal Circuit had rejected the claim interpretations on which the district court had relied in finding the absence of infringement, there remained factual findings of the district court that would form the basis of a complete defense to infringement. Those findings were never even considered by the court of appeals.

The findings to which we refer involve the substantiality of the differences between the Haworth panels, as originally conceived and patented, and the accused Steelcase panels. Focusing primarily on the difference between electric components that constitute an integral and essential part of an entire wall panel (the original Haworth design) and components that may be optionally removed (as in the case of the accused Steelcase products), the district court found that "Steelcase's accused wall systems are so far changed in principle from the wall systems of claims 5 and 29 that they perform a

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[12] Even there, however, it would be desirable and responsible for the court of appeals to explain whether the infringement is "literal" or under the doctrine of "equivalents," if only for purposes of providing guidance to the industry regarding the application of the patent to other products.

somewhat similar but greatly improved function in a substantially different way." Pet. App. 53a.[13]

Here, even assuming that the court of appeals correctly broadened the scope of the Haworth claims so that petitioner's products fall within their literal terms, these district court findings would still require consideration of the separate patent doctrine of "reverse equivalents." Under this doctrine, there is no liability for infringement for producing a new product that is literally covered by the claims of an existing patent but "performs the same or similar function *in a substantially different way.*" *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950) (emphasis added). *See also* Pet. App. 40a; *Westinghouse v. Boyden Power Brake Co.*, 170 U.S. 537, 568 (1898); *Autogiro Co. of America v. United States*, 384 F.2d 391, 399-400 (Ct. Cl. 1967). The purpose of this doctrine is to protect innovators who produce substantially new products that nevertheless fall within the description contained in a previous patent claim.

The application of the doctrine of reverse equivalents is a question of fact, *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d at 1123-24, and the district court in this case made repeated findings that provide a complete defense under that doctrine. Those findings were in no way undermined when the court of appeals reinterpreted the patent claims broadly. To the contrary, it is the existence of apparent "literal" infringement that calls the doctrine of reverse equivalents into play, requiring a determina-

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[13] *See also* Pet. App. 42a (addressing all of the Haworth claims generally) ("Steelcase successfully avoided the Haworth design, and uses instead features that are so far changed in principal [*sic*] that, while they may perform a similar function, they do so in a substantially different way."); Pet. App. 46a ("The Steelcase panel-to-panel connector is, thus, so far changed in principle from a fixed pivot axis hinge arrangement [in claim 18] that it performs a somewhat similar function in a substantially different way.")

tion whether the new product is not only literally but functionally within the scope of the patent. Thus, it was only by ignoring these findings that the court of appeals was able to arrive at the conclusion that petitioner's products infringe.[14]

3. As we have already suggested, the problems described in this case are far from unique. In many different types of patent cases, the Federal Circuit is prone to overlook the limits on appellate courts in reaching out to achieve a result that it considers correct.[15] To be sure, the Federal Circuit does have special expertise in the field of patent law. But that expertise does not extend to technical facts and does not justify what amounts to fact-finding based on cold and fragmented appellate records. It makes no sense for district courts to conduct lengthy patent trials, and prepare comprehensive findings, if their judgments are not to be given due respect on appeal.

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[14] At the very least, the existence of these findings would require a remand for consideration of the "reverse equivalents" issue in light of the reinterpreted patent claims.

The Federal Circuit's alternative holding that there might be infringement here under the doctrine of "equivalents" is equally insupportable. This issue too is one of fact, *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. at 609, and the same district court findings creating the issue of "reverse equivalents" would necessarily preclude application of the doctrine here.

[15] This tendency has been reflected in numerous recent petitions for certiorari raising issues concerning the Federal Circuit's compliance with the "clearly erroneous" requirement in Rule 52(a). *See Roll Mfg. Co. v. Nickson Indus.*, No. 85-26; *EWP Corp. v. Reliance Universal Inc.*, No. 85-29; *Delta Resins & Refractories, Inc. v. Ashland Oil Co.*, No. 85-1108; *J.A. Laporte, Inc. v. Norfolk Dredging Co.*, No. 86-215; *Barnes-Hind/Hydrocurve, Inc. v. Bausch & Lomb Inc.*, No. 86-1917; *Verdegaal Bros. v. Union Oil Co.*, No. 86-1994; *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 87-2046; *Gabriel Elec., Inc. v. Andrew Corp.*, No. 88-432; *Capital Controls Co. v. Chlorinators Inc.*, No. 88-637.

Here, of course, the problem is made even worse by the fact that the Federal Circuit did not even attempt to explain what it was doing. In a case affecting an entire industry, with billions of dollars of sales at issue, the Federal Circuit reversed the district court's judgment in a five-page unpublished order that contains merely assertions. No effort was made to come to grips with the complex factual materials that led the district court to interpret the Haworth patent claims specifically rather than broadly. And on the matter of infringement, the court simply ignored the important issue of "reverse equivalents." Litigants in such important and difficult cases, as well as the district courts, have a right to expect more than this from a federal court of appeals.

CONCLUSION

For these reasons, the writ of certiorari should be granted.

Respectfully submitted,

JOSEPH N. ONEK
PAUL M. SMITH
ONEK, KLEIN & FARR
2550 M Street, N.W.
Washington, D.C. 20037

DAVID S. FRY
JON D. BOTSFORD
STEELCASE INC.
901 44th Street, S.E.
Grand Rapids, Michigan 49508
Of Counsel

RUDOLF E. HUTZ
Counsel of Record
JOHN D. FAIRCHILD
CONNOLLY, BOVE, LODGE
& HUTZ
1220 Market Building
P.O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141
Counsel for Petitioners